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REMARKS

Claims 1-64 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

In the Office Action, claims 5-7, 22-24, 34-36, 50, 51 and 58-64 have been withdrawn from further consideration as being drawn to a non-elected species. However, claim 5 clearly reads on Species I. Notably, claim 8, which has not been withdrawn from examination, depends from claim 5. If claim 8 reads on the elected species, claim 5 has to read on the elected species. The same reasoning applies to claims 22 and 34. Moreover, claims 58-61 and 64 clearly should be examined with the present application. All of the elements of claims 58-61 and 64 can be found in Fig. 1 or Fig. 1a. Accordingly, Applicants submit that claims 5, 22, 34, 58-61 and 64 should be examined in the present application.

Claims 1-4, 9 and 10 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,646,210 to Skogler et al. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Applicants respectfully assert that the Examiner has not yet met his burden of establishing a prima facie case of anticipation with respect to the rejected claims.

Claim 1 defines an interior rearview mirror for a vehicle having a front windshield comprising a mounting bracket adapted to be mounted inside the vehicle in a location proximate to or on the front windshield of the vehicle, a mirror housing coupled to the mounting bracket, a reflective element located within the mirror housing, the reflective element having a front face defining a reflecting plane and being configured to reflect an image having a reflecting component in a first direction out of the mirror housing and a light source located within the mirror housing. The light source emits light along a beam axis. The beam axis has a directional component in a second direction, wherein the first direction and the second

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direction are perpendicular to the reflecting plane and the first direction is opposite to the second direction.

The prior art of record does not disclose or suggest the above noted features of claim 1. According to the Office Action, the Skogler et al. '210 patent discloses a vehicle mirror and light assembly having a mounting bracket 11, a mirror housing 15, a reflective element 24, a light source 98, a rear section and a bezel 56. The Skogler et al. '210 patent discloses a light assembly 40 having a bulb 98 therein that is configured to be connected to a mirror case 15 of a rearview mirror assembly. According to the Skogler et al. '210 patent, the light assembly 40 is adapted for coupling to the back of the mirror case 15. See lines 64-66 of column 5. Therefore, the Skogler et al. '210 patent does not disclose or suggest a light source located within the mirror case 15. Accordingly, the Skogler et al. '210 patent does not disclose or suggest all of the features of claim 1 as outlined above including a light source located within a mirror housing as the bulb 98 is not located within the mirror case 15. Therefore, claim 1 is in condition for allowance over the Skogler et al. '210 patent.

Claims 2-4, 9 and 10 depend from claim 1, and since claim 1 defines unobvious patentable subject matter over the Skogler et al. '210 patent as discussed above, claims 2-4, 9 and 10 define patentable subject matter. Furthermore, in regard to claim 2, the prior art of record does not disclose or suggest a mirror housing including a rear housing section and a bezel. According to the Office Action, the Skogler et al. '210 patent includes a bezel 56. However, the element 56 of the Skogler et al. '210 patent is a rectangular lens opening in a bottom wall 52 of the lens housing 40. Therefore, the Skogler et al. '210 patent does not disclose or suggest that the mirror case 15 includes a bezel. Moreover, in regard to claim 4, the Skogler et al. '210 patent does not disclose or suggest a deviator configured to reconfigure the light emitted from the light source through a bottom opening of the housing. Notably, the Office Action has not set forth any such deviator in the Skogler et al. '210 patent. Accordingly, claims 2-4, 9 and 10 are in condition for allowance over the Skogler et al. '210 patent.

Claims 1-4, 9, 10, 12, 13, 17, 18, 20, 21, 26, 27, 29, 30, 32, 33, 38, 39, 41, 42, 45-49, 52, 53 and 55 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S.

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Patent No. 6,152,590 to Fürst et al. The standard for rejecting a claim as being anticipated by the prior art is outlined above.

The prior art of record does not disclose or suggest the above noted features of claim 1. Claim 1 states, among other things, that the interior rearview mirror includes a reflective element having a front face defining a reflecting plane, with the reflective element configured to reflect an image having a reflecting component in a first direction out of the mirror housing, a light source located within the mirror, with the light source emitting light along a beam axis and the beam axis having a directional component in a second direction, when the first direction and the second direction are perpendicular to the reflecting plane, and the first direction is opposite to the second direction. However, as clearly illustrated in Fig. 1 of the Fürst et al. '590 patent, the LEDs 9 of the Fürst et al. patent emit light in a direction parallel to the reflecting plane of the reflecting element 2 such that the LEDs 9 do not emit light along a beam axis having a directional component in a second direction. Accordingly, claim 1 is in condition for allowance.

Claims 2-4, 9, 10, 12 and 13 depend from claim 1, and since claim 1 defines unobvious patentable subject matter as discussed above, claims 2-4, 9, 10, 12 and 13 define patentable subject matter. Furthermore, in regard to claim 2, the Fürst et al. '590 patent does not disclose or suggest a mirror housing include a rear housing section and a bezel. According to the Office Action, the bezel of the Fürst et al. '590 patent is not labeled. Applicants submit that the reason that the Fürst et al. '590 patent does not label any bezel is because the Fürst et al. '590 patent does not include any bezel. If such a rejection of claim 2 is maintained in a further Office Action, Applicants respectfully request the Examiner to point out the bezel of the Fürst et al. '590 patent. Moreover, in regard to claim 4, the Fürst et al. '590 patent does not disclose or suggest a deviator configured to redirect the light emitted from the light source through the bottom opening of the housing. Notably, the cover plates 7 of the Fürst et al. '590 patent do not redirect the light through any opening of the housing 4. Furthermore, in regard to claim 9, the Fürst et al. '590 patent does not disclose both a deviator and a lens. The Office Action has apparently rejected these two elements of claim 9 over a single element of the Fürst et al. '590 patent. Moreover, in regard to claim 12, the Fürst et al. '590 patent does not

disclose or suggest a printed circuit board located adjacent a second face of a carrier plate with a first side facing the carrier plate. The printed circuit board 8 of the Fürst et al. '590 patent is not located adjacent the carrier plate and does not include a first side facing the carrier plate and a second side facing away from the carrier plate, with a light source connected to the second side of the printed circuit board. Accordingly, claims 2-4, 9, 10, 12 and 13 are in condition for allowance.

Claim 17 defines a rearview mirror subassembly comprising a housing having a front opening and a bottom opening, a reflective element located within the housing, the reflective element configured to reflect light through the front opening, a light source located within the housing and a deviator configured to redirect the light emitted from the light source to the bottom opening of the housing.

The prior art of record does not disclose or suggest the above noted features of claim 17. According to the Office Action, the Fürst et al. '590 patent includes a housing 4, a reflective element 2, a light source 5 and a deviator 7. However, the Fürst et al. '590 patent does not include all of the features of claim 17 including a deviator configured to redirect light emitted from a light source to a bottom opening of a housing. The cover 7 of the Fürst et al. '590 patent does not redirect light to a bottom opening of a housing. Accordingly, claim 17 is in condition for allowance.

Claims 18, 20, 21, 26, 27, 29 and 30 depend from claim 17, and since claim 17 defines unobvious patentable subject matter as discussed above, claims 18, 20, 21, 26, 27, 29 and 30 define patentable subject matter. Furthermore, in regard to claim 18, the Fürst et al. '590 patent does not disclose or suggest a light source emitting light along a beam axis, with a beam axis having a directional component in a second direction as defined by claim 18. The Fürst et al. '590 patent includes LEDs 9 that do not emit light having a directional component in a second direction. Moreover, in regard to claim 20, the Fürst et al. '590 patent does not disclose or suggest a beam axis that is parallel to the first direction. The light emitted from the LEDs 9 of the Fürst et al. '590 patent is perpendicular to the first direction. Furthermore, in regard to claim 21, the Fürst et al. '590 patent does not disclose or suggest a housing having a bezel as discussed above in regard to claim 2. Moreover, in regard to claim 26, the Fürst et

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al. '590 patent does not disclose or suggest both a deviator and a lens. Furthermore, in regard to claim 30, the Fürst et al. '590 patent does not disclose or suggest a printed circuit board including a first side facing the carrier plate and a second side facing away from the carrier plate, with a light source connected to the second side of the printed circuit board. Accordingly, claims 18, 20, 21, 26, 27, 29 and 30 are in condition for allowance.

Claim 32 defines a rearview mirror subassembly for a vehicle comprising a mirror housing having a bottom opening, a reflective element located within the mirror housing, the reflective element being configured to reflect an image having a reflecting component in a first direction out of the mirror housing and a light source located within the mirror housing. The light source emits light along a beam axis. The beam axis has a directional component in a second direction. A deviator is configured to redirect the light emitted from the light source to the bottom opening of the housing, wherein the first direction and the second direction are parallel and opposite.

The prior art of record does not disclose or suggest the above noted features of claim 32. The Fürst et al. '590 patent does not include a mirror housing, a reflective element, a light source and a deviator as claimed in claim 32. Light emitted from the LEDs 9 do not have a directional component in a second direction as defined by claim 32 and the cover 7 does not redirect light emitted from the LEDs 9 to a bottom opening of any housing. Accordingly, claim 32 is in condition for allowance.

Claims 33, 38, 39, 41, 42 and 45 depend from claim 32, and since claim 32 defines unobvious patentable subject matter as discussed above, claims 33, 38, 39, 41, 42 and 45 define patentable subject matter. Furthermore, in regard to claim 33, the Fürst et al. '590 patent does not disclose or suggest a mirror housing including a rear housing section and a bezel. Moreover, in regard to claim 38, the Fürst et al. '590 patent does not disclose or suggest both a deviator and a lens. Furthermore, in regard to claim 42, the Fürst et al. '590 patent does not disclose or suggest a printed circuit board having a first side facing a carrier plate and a second side facing away from a carrier plate, with a reflective element being located adjacent a first face of the carrier plate and a light source connected to a second side of the printed circuit board. Moreover, in regard to claim 45, the Fürst et al. '590 patent does

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not disclose or suggest a beam axis that is parallel to the first direction as defined in claim 32. A beam axis of the LEDs 9 is in a direction perpendicular to the first direction. Additionally, claim 45 depends from claim 44, which has not been indicated as being anticipated by the Fürst et al. '590 patent. Accordingly, claims 33, 38, 39, 41, 42 and 45 are in condition for allowance.

Claim 46 defines a rearview mirror subassembly comprising a housing having a front opening and a bottom opening, a reflective element located within the housing, the reflective element having a front face configured to reflect light through the front opening and a rear face, a printed circuit board including a first side facing towards the reflective element and a second side facing away from the reflective element and a LED device directly connected to the second side of the printed circuit board, wherein light from the LED device exits the housing through the bottom opening in the housing.

The prior art of record does not disclose or suggest the above noted features of claim 46. According to the Office Action, the Fürst et al. '590 patent includes a housing 4, a reflective element 2, a printed circuit board 8 and an LED device 6. However, the printed circuit board 8 of the Fürst et al. '590 patent does not include a first side facing towards the mirror element 2 and a second side facing away from the mirror element 2 with the LED module 6 directly connected to the second side of the printed circuit board 8. Notably, the printed circuit board 8 of the Fürst et al. '590 patent is part of the LED module 6 such that the Office Action is very confusing and Applicants submit that the Office Action does not set forth a *prima facie* rejection of claim 46. Nevertheless, Applicants submit that the Fürst et al. '590 patent does not disclose or suggest an LED device directly connected to a second side of a printed circuit board as claimed in claim 46. Accordingly, claim 46 is in condition for allowance.

Claims 47-49, 52, 53 and 55 depend from claim 46, and since claim 46 defines unobvious patentable subject matter as discussed above, claims 47-49, 52, 53 and 55 define patentable subject matter. Furthermore, in regard to claim 47, the Fürst et al. '590 patent does not disclose or suggest an LED device that emits light along a beam axis and the beam axis of the light is non-parallel with a line perpendicular to a second side of the printed circuit board.

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In the Fürst et al. '590 patent, the beam axis of light emitted from the LED device is parallel with a line perpendicular to the second side of the printed circuit board. Moreover, in regard to claim 48, the Fürst et al. '590 patent does not disclose or suggest a beam axis of the light emitted from the LED device being substantially perpendicular to a line perpendicular to the second side of the printed circuit board. The light emitted from the LED device of the Fürst et al. '590 patent is parallel to a line perpendicular to a second side of the printed circuit board. Furthermore, in regard to claim 49, the Fürst et al. '590 patent does not disclose or suggest a housing including a rear housing section and a bezel. Accordingly, claims 47-49, 52, 53 and 55 are in condition for allowance.

Claims 8, 14-16, 19, 25, 31, 37, 43, 44, 56 and 57 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the Fürst et al. '590 patent in view of U.S. Patent Application Publication No. 2003/0043589 to Blank. The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

In order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. § 706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992); M.P.E.P. §2142. Applicants respectfully assert that the

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Examiner has not yet met the Examiner's burden of establishing a prima facie case of obviousness with respect to the rejected claims. Consequently, the Examiner's rejection of the subject claims is inappropriate, and should be withdrawn.

The prior art of record does not disclose or suggest the features of claims 8, 14-16, 19, 25, 31, 37, 43, 44, 56 and 57. First, all of these claims depend from either claim 1, 17, 32 or 46, and since claims 1, 17, 32 and 46 define patentable subject matter as discussed above, claims 8, 14-16, 19, 25, 31, 37, 43, 44, 56 and 57 define patentable subject matter.

Second, in regard to the first criterion of obviousness, there is no suggestion or motivation for combining the references as set forth in the Office Action. According to the Office Action, the Blank '589 publication includes light emitting diodes 260, 262, 264. However, the elements 260, 262 and 264 of the Blank '589 publication are photo-sensors for sensing light directed towards a mirror. The photo-sensors 260, 262, 264 do not emit light and are not light-emitting diodes. Therefore, Applicants submit that the motivation for combining the references as set forth in the Office Action is improper as the Blank '589 publication does not include any light-emitting diodes.

In regard to the third criterion of obviousness, the prior art of record does not disclose or suggest any of the features of the claims. First, in regard to claims 8, 25 and 37, claims 8, 25 and 37 depend from claims 5, 22 and 34, respectively. Since claims 5, 22 and 34 have not been rejected, claims 8, 25 and 37 have not been properly rejected in the Office Action. Therefore, since claims 5, 22 and 34 define patentable subject matter, claims 8, 25 and 37 define patentable subject matter. Furthermore, even if the combination as set forth in the Office Action was proper, a beam axis of the light sources does not change such that the combination would not include the features of claims 15, 16, 19 and 44. Finally, in regard to claim 57, the Office Action has a discussion about the reflectance value of the reflective element. However, claim 57 does not include any such limitation. Accordingly, claims 8, 14-16, 19, 25, 31, 37, 43, 44, 56 and 57 are in condition for allowance.

Claims 11, 28, 40 and 54 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the Fürst et al. '590 patent in view of U.S. Patent No. 5,151,816 to Varaprasad et al. The standard for rejecting a claim as being obvious is outlined above.

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Claims 11, 28, 40 and 54 depend from claims 1, 17, 32 and 46, respectively. Since claims 1, 17, 32 and 46 define patentable subject matter as discussed above, claims 11, 28, 40 and 54 define patentable subject matter. Accordingly, claims 11, 28, 40 and 54 are in condition for allowance.

In the Office Action, claims 5-7, 22-24, 34-36, 50, 51 and 58-64 have been withdrawn from further consideration. All of these claims depend from either claim 1, 17, 32 or 46. Since claims 1, 17, 32 and 46 define patentable subject matter as discussed above, Applicants respectfully request rejoinder of the withdrawn claims as provided by 37 C.F.R. §1.141. Accordingly, Applicants further submit that claims 5-7, 22-24, 34-36, 50, 51 and 58-64 are in condition for allowance.

All pending claims 1-64 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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Date

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